

REMARKS

Response to the §103 Rejections

In the March 31, 2008 Office Action, the Examiner finalized the rejections against claims 1-7 and 10-14 under 35 U.S.C. §103(a) as allegedly obvious over U.S. Patent No. 5,830,485 (hereinafter “the ‘485 Patent”) and European Patent Application Publication No. 1013724 (hereinafter “the ‘724 Publication”) in view of Japanese Patent Application Publication No. 2-184618 (hereinafter “the ‘618 Publication”).

In response, Applicants have hereby amended claim 1, from which claims 2-7 and 10-14 depend, to positively recite “[a] composition for topical application to the skin comprising (a) a transparent component having a light transmission value of greater than about 70% and an average particle size of about 1 micron to about 10 microns; (b) a non-interference platelet component having an average particle size of about 15 microns to about 22 microns, the platelet exhibiting a light transmission value of about 20% to about 70%, and a light reflectance value of about 10% to about 20%.” Support for such claim amendments can be readily found in the instant specification at page 3, line 22 and page 4, line 28.

The Examiner asserted in the March 31, 2008 Office Action that the ‘485 Patent discloses a colored composition comprising particulate fillers (such as glass beads) with particle size ranging from 0.8 to 180 microns and pigments with particle size ranging from 0.1 to 25 microns, that the ‘618 Publication discloses that glass beads in the cosmetic composition have at least 85% of light transmission, and that the ‘724 Publication discloses a pigment mixture comprising TiO₂ coated alumina (Al₂O₃) flakes and BiOCl flakes. Consequently, the Examiner concluded that it would have been obvious for a person ordinarily skilled in the art to yield the claimed invention of the present application by incorporating the pigment disclosed by the ‘724

Publication into the colored composition disclosed by the '485 Patent and then by adjusting the amount and particle size of the respective components (see Office Action, page 3, paragraphs 1-4).

However, a closer reading of the primary reference, i.e., the '485 Patent, shows that the '485 Patent discloses a very specific type of composite particles, which are formed by coating particular fillers with a polymer that has been pre-combined with pigments, while the full complement of such pigments is combined with the polymer that coats over the particulate fillers (see the '485 Patent, column 1, lines 41-46). More specifically, the '485 Patent indicates that the pigments, when in form of solid particles, must have a particle size or diameter that "is less than that of the filler particles" (see the '485 Patent, column 3, lines 1-4), so that the pigment particles can be readily incorporated into the polymeric coating that covers the outer surface of the particulate fillers. If the pigment particles disclosed by the '485 patent were larger than the particulate fillers themselves in size, it would be impossible for the pigment particles to form a coating over the particulate fillers together with the polymer. Therefore, it is clear that although the '485 Patent discloses very wide ranges for the absolute particle sizes of the particulate fillers and the pigments, i.e., 0.8 to 180 microns for the particulate fillers and 0.1 to 25 microns for the pigment particles, the relative particle sizes of the particulate fillers and the pigments as disclosed by the '485 Patent are nevertheless very limited, i.e., the particle size of the pigments has to be less than that of the particulate fillers. Otherwise, the pigment particles would be too large to coat over the particulate fillers as a part of the polymeric coating.

In light of the above-discussed teachings by the '485 Patent, even if a person ordinarily skilled in the art would have found it obvious to incorporate the pigments disclosed by the secondary reference (i.e., the '724 Publication) into the colored composition disclosed by the

'485 Patent, such incorporation would still follow the express teachings of the '485 Patent with respect to the relative particle sizes of the particulate fillers and the pigments. In other words, even if a person ordinarily skilled in the art would be motivated to incorporate the pigment mixture of TiO₂-coated alumina (Al₂O₃) flakes and BiOCl flakes disclosed by the '724 Publication into the color composition disclosed by the '485 Patent, the particle sizes of the incorporated TiO₂-coated alumina (Al₂O₃) flakes and BiOCl flakes would still have to be less than that of the particulate fillers (e.g., glass beads) disclosed by the '485 Patent, in order to allow such pigment mixture to be incorporated into the polymer coating that coats over the particulate fillers, as expressly taught by the '485 Patent.

In contrast, the amended claim 1 of the present application positively recites a non-interference platelet component (such as, for example, alumina flakes) with an average particle size that is more than that of a transparent component (such as, for example, glass beads), i.e., the average particle size of the non-interference platelet component ranges from about 15 microns to about 22 microns, while the average particle size of the average particle size of the transparent component ranges from about 1 micron to about 10 microns.

In the March 31, 2008 Office Action, the Examiner asserted that "it would have been obvious to one of ordinary skill in the art at the time of invention to adjust... particle size of the herein components" (see Office Action, page 3, lines 18-19). However, it has been well established that a prior art reference must be considered in its entirety (i.e., as a whole) including portions that would lead away from the claimed invention, and that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Gordon*, 733 F.2d

900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, the primary reference, i.e., the '485 Patent, expressly teaches away from using pigment particles that have an average particle size that is more than that of the particulate fillers. Any proposed modification of the particle size of the components against such express teaching by the '485 Patent, i.e., making the pigment particles larger in size than the particulate fillers, would have rendered the prior art invention of the '485 Patent unsatisfactory for its intended purpose and is therefore non-obvious.

Based on the foregoing, it is clear that the amended claims of the present application patentably distinguish over the combination of the '485 Patent and the '724 Publication by positively reciting a non-interference platelet with an average particle size ranging from about 15 microns to about 22 microns and a transparent component with an average particle size ranging from about 1 micron to about 10 microns.

The combination of the above-specified non-interference platelet and transparent component by the present invention results in an improved cosmetic composition which, when applied to the skin, has the effect of diminishing or eliminating the appearance of skin blemishes, while at the same time permitting surrounding clear skin to retain its normal, healthy appearance (see the instant specification, page 2, lines 5-7). In comparison, although the hypothetical combination of the '485 Patent and the '724 Publication as proposed by the Examiner may have resulted in a cosmetic composition with improved hiding power, there is no evidence that such cosmetic composition would at the same time permit surrounding clear skin to retain its normal, healthy appearance.

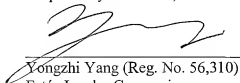
The newly cited '618 Publication was cited by the Examiner to support the finding that glass beads in cosmetic compositions have a light transmission value of at least 85% (see the

Office Action, page 3, lines 14-15). Such applied disclosure of the '618 Publication does not remedy the above-discussed deficiency of the '485 Patent and the '714 Publication.

Accordingly, Applicants respectfully request the Examiner to reconsider, and upon reconsideration to withdraw, the §103 rejection against the pending claims of the present application.

In view of the foregoing amendments and remark, it is firmly believed that the present application is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Yongzhi Yang', is written over a horizontal line.

Yongzhi Yang (Reg. No. 56,310)
Estée Lauder Companies
155 Pinelawn Road, Ste. 345 S.
Melville, NY 11747

Telephone No.: 631-414-6089
Facsimile No.: 631-531-1340